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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,299	12/05/2000	Kenneth H. Falchuk	healre01.012	7848
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GORDON E NELSON PATENT ATTORNEY, PC 57 CENTRAL ST PO BOX 782 ROWLEY, MA 01969			EXAMINER PASS, NATALIE	
			ART UNIT	PAPER NUMBER
			3626	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/03/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/730,299

Applicant(s)

FALCHUK ET AL.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2007 & 30 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 16 March 2007 and the Supplementary Amendment filed 30 March 2007. Claim 1 has been amended. Claims 1-4 remain pending.

Claim Rejections - 35 USC §101

2. Claims 1-2 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter.

(A) Under the guidance of recent case law, the requirements of 35 U.S.C. § 101 are met when “the practical application of the abstract idea produces a useful, concrete, and tangible result” (State Street Bank & Trust Co. vs. Signature Financial Group, Inc., 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998)).

As per Applicant’s recited invention, in general a method for providing continuing medical education credit is conceptually useful for providing accreditation to a physician. Although claim 1 has now been amended to recite, “determining whether any continuing medical education credit is to result from ... [...] ... and if continuing medical education credit is to result ... [...] ...,” and the method consequently now, in the eventuality that the determination has had a positive result, yields a useful result (i.e. credit), it is respectfully submitted that the method recited still fails to yield a useful result if the determination has produced a negative result, since

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there is no positive action recited if the determination has been made that no credit is to result from the consultation; accordingly, the invention continues to fail to recite the usefulness required to satisfy the requirements of 35 U.S.C. § 101.

As such, although claims 1-2 produce a concrete result that is assured or repeatable, and now meet the tests for concreteness and tangibility, and although the amendment to claim 1 has added usefulness for one of the determination results, as described above, in light of the above it is respectfully submitted that the claimed invention, as recited in claims 1 and 2, although tangible and concrete, is not useful, and thus fails to satisfy the requirements of 35 U.S.C. § 101.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minnesota

Medical Association Report on Telemedicine article, September 1996, URL:

<<http://www.mnmed.org/Protected/telemedicine.pdf>>, hereinafter known as Telemedicine, and

Bringing Health Care Online: The Role of Information Technologies, Chapter 5: Telemedicine:

Remote Access to Health Services and Information article, September 1995, URLs:

<<http://www.wws.princeton.edu/ota/disk1/1995/9507/950707.PDF>> and

<<http://www.wws.princeton.edu/ota/disk1/1995/9507/950701.PDF>>, hereinafter known as

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Remote, for substantially the same reasons given in the previous Office Action (paper number 20061206). Further reasons appear hereinbelow.

(A) Claim 1 has been amended to include the recitation of

- “determining whether ... [...] ... is to result ... [...] ... and if continuing medical education credit is to result ...” on lines 10-12.

As per newly amended claim 1, Telemedicine and Remote teach a method as analyzed and discussed in the previous Office Action (paper number 20061206) further comprising determining whether any continuing medical education credit is to result from the consultation represented by the comment (Telemedicine; page 11, column 2, paragraph 4) and if continuing medical education credit is to result, recording the resulting continuing medical education credit in a database accessible from the intermediary (Telemedicine; page 1, column 2, paragraph 2 to page 2, column 1, paragraph 1, page 3, column 1, paragraph 4, page 4, column 2, paragraph 4, page 14, column 1, paragraphs 3-4, page 19, column 1, paragraphs 2-3, page 22, column 1, paragraph 4 to column 2, paragraph 2); Examiner interprets Telemedicine’s teachings of “[d]evelop a means of providing appropriate continuing medical education credit, acceptable toward the Physician’s Recognition Award, for educational consultations using telemedicine” to teach a form of determining whether any continuing medical education credit is to result from the consultation represented by the comment.

The remainder of claim 1 is rejected for the same reasons given in the prior Office Action (paper number 20061206, section 6, pages 4-6), and incorporated herein.

The motivations for combining the respective teachings of Telemedicine and Remote are as given in the rejection of claim 1 in the previous Office Action (paper number 20061206), and incorporated herein.

5. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minnesota Medical Association Report on Telemedicine article, September 1996, URL: <<http://www.mnmed.org/Protected/telemedicine.pdf>>, hereinafter known as Telemedicine, and Bringing Health Care Online: The Role of Information Technologies, Chapter 5: Telemedicine: Remote Access to Health Services and Information article, September 1995, URLs: <<http://www.wws.princeton.edu/ota/disk1/1995/9507/950707.PDF>> and <<http://www.wws.princeton.edu/ota/disk1/1995/9507/950701.PDF>>, hereinafter known as Remote, as applied to claims 1 and 2 above and further in view of Abrahamson et al, U.S. Patent Number 5, 002, 491 for substantially the same reasons given in the previous Office Action (paper number 20061206). Further reasons appear hereinbelow.

(A) Claims 3-4 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20061206, section 7, pages 7-9), and incorporated herein.

Response to Arguments

6. Applicant's arguments on pages 5-10 of the response filed 30 March 2007 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 30 March 2007.

(A) On page 5, paragraph 1 of Applicant's response filed 30 March 2007 Applicant argues the rejection of claims 1-4 under 35 U.S.C. § 101 in light of amendments to claim 1. Applicant's arguments have been fully considered but they are not persuasive, as detailed in Section 2 above.

At pages 5-10 of the 30 March 2007 response Applicant argues that the features claimed in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references, including limitations recited in the preamble, and including the newly added limitations of the amendment filed 30 March 2007, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Telemedicine, Remote, and Abrahamson, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 20061206), and incorporated herein. In particular, Examiner notes that the features of "providing continuing medical education credit to a first physician for a consultation between the first physician and a second physician via an intermediary" as recited in the preamble of claim 1 are taught by the applied references (Telemedicine; see at least page 4, column 2, paragraphs 2-6), (Remote; page 168, column 1, paragraph 1-3).

With regard to Applicant's argument at page 6, paragraph 6 of the 30 March 2007 response that the Telemedicine reference "discloses *nothing whatever* about such consultations taking place via *any* intermediary," Examiner respectfully disagrees. Examiner interprets

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Telemedicine's teachings of "[o]ther telemedical physician education systems include: the Medical News Network, the Physicians Television Network, and the Pyramed Network, all of which offer continuing medical education credits to physicians (AMA CMS/CME Report A-94)" (emphasis added) (Telemedicine; page 4, column 2, paragraph 4) and Remote's teachings of "[p]hysicians in remote areas who use the MCG [Medical College of Georgia] system for consultations are given credit hours toward meeting their continuing medical education (CME) requirements, which are necessary for license renewals" (emphasis added) (Remote; page 168, column 2, paragraphs 1-3) as teaching "Teleconsultation" (Remote; page 166, column 1, paragraph 1) or a form of consultations taking place via an intermediary that is connected by a "Telemedicine Health Care Network" (Remote; Figure 5-1) (reads on "telecommunications system").

With regard to Applicant's discussion in the last paragraph on page 6 of the 30 March 2007 response regarding the environment set up by the preamble, Examiner notes that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Nevertheless, Examiner notes that the environment set up by the preamble has been addressed in the preceding paragraphs in this Office Action.

With regards to Applicant's arguments on pages 7-8 of the 30 March 2007 response, Examiner notes that Applicant appears to rely upon only a small subset of the applied art. Further it is the entire combined applied reference(s), and not only the cited passages that must be considered when evaluating whether or not the applied references teach the cited limitations.

With regards to Applicant's arguments on page 8 of the 30 March 2007 response, that the applied art fails to disclose the limitation recited in claim 1 of "receiving a comment made with regard to the consultation via the telecommunications system from the second physician," Examiner respectfully disagrees. Examiner interprets Telemedicine's teachings of "the fact that new technologies such as optical scanners, facsimile transmissions, E-mail, teleradiology, and video conferencing have joined the telephone and mail in the traditional consultation process" and "the provision of advice or consultation to another physician who is primarily responsible for the care of the individual patient" (emphasis added) (Telemedicine; page 14, paragraph bridging columns 1-2); as teaching a form of receiving a comment made with regard to the consultation via the telecommunications system from the second physician.

With regards to Applicant's arguments on page 8 of the 30 March 2007 response, that the Telemedicine reference fails to teach the medical information specialist's role in determining "whether the first physician" will receive CME credit for the consultation, Examiner respectfully notes that this is not a claimed limitation. Further, as discussed earlier, Examiner interprets Telemedicine's teachings of "[d]evelop a means of providing appropriate continuing medical education credit, acceptable toward the Physician's Recognition Award, for educational consultations using telemedicine" (emphasis added) (Telemedicine; page 11, column 2,

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paragraph 4) and Remote's teachings of "[p]hysicians in remote areas who use the MCG [Medical College of Georgia] system [reads on "through an intermediary"] for consultations are given credit hours toward meeting their continuing medical education (CME) requirements, which are necessary for license renewals" (emphasis added) (Remote; page 168, column 2, paragraphs 1-3) to teach a form of determining by a medical information specialist in the intermediary whether any continuing medical education credit is to result from the consultation represented by the comment. Moreover, Examiner interprets a "medical information specialist" to broadly define someone who specializes in the handling of medical information, including, for example, a secretary or administrator who records relevant information; and Examiner further notes that would have been obvious to one of ordinary skill in the art at the time the invention was made that an intermediary such as MCG (Medical College of Georgia), which enables consultations and which gives CME credits would employ medical information specialists to record relevant information, such as comments and consultations, for determination of CME credits.

With respect to Applicant's argument on page 8 that a *prima facie* case of obviousness has not been established the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence has

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been presented of corresponding claim elements in the prior art and the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 20061206 and present Office Action) have been expressly articulated.

With regards to Applicant's arguments on pages 8-9 of the 30 March 2007 response, these arguments have already been discussed earlier in this Office Action. Furthermore, Examiner notes that Applicant appears to rely upon only a small subset of the applied art. Moreover, it is the entire combined applied reference(s), and not only the cited passages that must be considered when evaluating whether or not the applied references teach the cited limitations.

With regard to Applicant's argument in the last paragraph on page 10 that the applied reference fail to disclose limitations of claim 2, Examiner interprets a "medical information specialist" to broadly define someone who specializes in the handling and distribution of medical information, including, for example, a secretary or administrator who records relevant medical information; and Examiner further notes that would have been obvious to one of ordinary skill in the art at the time the invention was made that an intermediary such as MCG (Medical College of Georgia), which enables consultations and which gives CME credits, would employ medical information specialists to record relevant information such as comments and consultations, and to retrieve and distribute instructional material to inform participants in requirements for receiving a CME credit.

Conclusion

7. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please
label "PROPOSED" or "DRAFT" on the front page of
the communication and do NOT sign the
communication.

After Final communications should be labeled "Box AF."

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Natalie A. Pass

March 31, 2007


THOMAS A. DIXON
PRIMARY EXAMINER